



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,935	12/09/2003	Daiki Ninomiya	245781US0	2382
22850	7590	09/29/2008		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
CHAWLA, JYOTI				
ART UNIT		PAPER NUMBER		
1794				
NOTIFICATION DATE		DELIVERY MODE		
09/29/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com

oblonpat@oblon.com

jgardner@oblon.com

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/729,935

**Applicant(s)**

NINOMIYA ET AL.

**Examiner**

JYOTI CHAWLA

**Art Unit**

1794

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 17 September 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because:  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 5-7-11-13-23 and 25-29.  
Claim(s) withdrawn from consideration: 1-4.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☒ Other: See Continuation Sheet.

/KEITH D. HENDRICKS/  
Supervisory Patent Examiner, Art Unit 1794

Continuation of 3. NOTE: Applicant's amendments filed 9/18/2008 have not been entered because:

Amendment to the claims filed 9/17/2008 has not been entered as it raises new issues that would require new search and consideration. The independent claims 5 and 17 have been amended from "(i) preparing solid koji by inoculating one or more microorganisms with protein hydrolysis potency in raw materials containing vegetable protein" to "(i) Preparing solid koji...one or more microorganisms, wherein said microorganisms have protein hydrolysis potency and said microorganisms may be one or more belonging to a genus selected from the group consisting of Lactococcus, Aspergillus, Rhizopus, Mucor, and Monascus."

Step (ii) of the independent claim has been amended from "(ii) hydrolyzing the protein by adding a solution to the resulting solid koji, at a sodium chloride concentration of 5% by weight or less to form unrefined soy, and then fermenting the unrefined soy" to "(ii) forming unrefined soy by adding a solution to said solid koji, wherein the sodium chloride concentration of the unrefined soy is 5% by weight or less to form based on the total weight of said unrefined soy, purging the fermentation tank with nitrogen, sealing the fermentation tank, and fermenting the unrefined soy by hydrolyzing the soybean protein at temperature ranging from 30-37.degree.C for 40-144 hours".

Claim 5 has been further amended to exclude the term "raw material" and addition of phrase "to the unrefined soy", which was not in the previously examined claims. Independent claim 17 has been amended in a similar way as claim 5. Claims 7 and 9 have also been amended to include time and temperature ranges for step (ii), which were not examined in the previously rejected claims in this context. Claims 19 and 21 have also been amended similar to claims 7 and 9. Further, claims 11 and 23 have also been amended to include the processing conditions "under nitrogen atmosphere" which was not recited as such in the rejected claims.

Amendments to independent claims 5 and 17 and dependent claims 7, 9, 11, 19, 21, and 23, recite limitations in a method that were not examined as recited before and thus, would require new search and consideration.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's comments filed 9/17/2008, pages 5-8 have been considered but have not been found persuasive. The arguments address the references used as prior art in regards to the newly added amendments to claims especially claims 5 and 17, which have not been entered. Thus, the arguments are moot and the rejections are maintained for reasons of record.

Continuation of 13. Other: Applicant's cancellation of claims 6 and 18 overcomes claim objection of "improper dependence" made in the final office action dated April 17, 2008.